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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/090,067	06/03/1998	JAMES D. REDMOND	NIS0007	3497
23735	7590	07/28/2004	EXAMINER	
DIGIMARC CORPORATION 19801 SW 72ND AVENUE SUITE 250 TUALATIN, OR 97062			HENDERSON, MARK T	
		ART UNIT	PAPER NUMBER	
			3722	

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/090,067

Filing Date: June 03, 1998

Appellant(s): REDMOND ET AL.

Marianne McLaughlin Downing

For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
**JUL 28 2004**  
**GROUP 3700**

This is in response to the appeal brief filed May 6, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1, 6, 8-10, 21 and 26 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

GB-2,159,461A	Trew et al	12-1985
1,428,278	DOW	9-1922
4,239,261	RICHARDSON	4,239,261

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-6, 8-11, 13-16, 18-21 and 23-26 are rejected under 35 U.S.C. 103(a).

This rejection is set forth in a prior Office Action, mailed on December 2, 2003.

**(11) Response to Argument**

Appellants' arguments filed on May 6, 2004 have been fully considered, but they are not persuasive.

In regards to appellant's amendment filed with the Brief on May 6, 2004, the examiner submits that the amended claims have been entered and the rejection under 35 USC 112 has been withdrawn.

In regards to appellant's argument that the prior art of United Kingdom (UK) Patent (GB-2159461A) does not disclose wherein "the microfilm or microprint data becomes data that is resolved using a magnification lens", the examiner submits that the prior art states that the "micro print information (3) cannot be ascertained or readily ascertained by the naked eye (even with the aid of a magnifying lens) during normal use of the card. However, the prior art also discloses (on page 2, col. 1, lines 1-10) that the micro print information can be placed "into a suitably adapted reader or projector such information can be shown in greatly enlarged form on the screen of the reader or in a similar manner". The examiner interprets this disclosure to mean that although the microprint cannot be read or ascertained by a magnifying lens (alone), it can be read by a device such as a projector that uses or incorporates a magnifying lens to enlarge the micro print indicia. Projector devices inherently incorporate magnification lenses to ascertain microprint indicia. Both Samuels et al (3,765,755) and Crew (3,871,759) (submitted as extrinsic evidence only) disclose a projector that incorporates the use of

magnifying lenses to ascertain micro images. Since the UK Patent discloses printed indicia which can be viewed through the use of a magnifying lens (however, not alone or directly), there is motivation to combine the UK Patent reference with the Richardson reference as stated in examiner's office action.

In regards to appellant's arguments that there is no motivation to combine the UK Patent reference with the Dow Patent reference, the examiner submits that the UK Patent reference is cited for disclosing an anti-fraudulent identification document which discloses a first printed matter at a first location, a first scale (size) and a first color; and a second printed matter at a second location, a second scale and having a second color. However, the UK Patent does not disclose wherein the second color of the second printed matter provides minimal contrast, hiding the second printed matter from its immediate background. The Dow reference discloses a document having printed matter in a first and second color, wherein the colors have minimal contrast (in this case the colors have different optical properties) and can be printed in various hues (which means that the color properties can be slightly darker or lighter) to further effect minimal contrast from another color. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the UK Patent document with minimal contrasting hiding between two colors as taught by Dow for the purpose of providing another means in which to protect the document from fraud/anti-counterfeiting attempts (the UK Patent's intended purpose).

In regards to appellant's argument's that the Richardson reference does not disclose or teaches "using minimal contrast as a way to substantially hide the location of information and/or the information itself", the examiner submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Richardson reference, which was used as a supporting reference, was not used to disclose minimal contrast with a background color (Dow was used to disclose this limitation). The Richardson reference is only cited for disclosing hidden (covert) printed matter placed at a confidential location which can only be unresolved with the viewing person knowing where the printed matter location is and using a magnifying lens. Therefore, it would have been obvious to modify the UK's patent document with printed matter which is placed at confidential locations and only be unresolved with the viewing person's knowledge of the printed matter's location and further through the use of a magnifying lens as taught by Richardson for the purpose of providing a means in which to further avoid fraudulent attempts.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark Henderson  
Examiner

July 23, 2004

Conferees



Andrea Wellington  
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